

REMARKS

I. Introduction

Claims 1 to 27 are currently pending in the present application. Claims 8 to 11 and 24 are allowed. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1 to 7, 12, and 13 Under 35 U.S.C. § 112

Claims 1 to 7, 12, 13 and 28 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement.

While Applicants do not agree with the merits of the rejection, to facilitate matters, claims 1 and 14 have been amended herein without prejudice to obviate the present rejection.

In view of the foregoing, withdrawal of the rejection is respectfully requested.

III. Rejection of Claims 14 to 23, 26, and 27 Under 35 U.S.C. § 103(a)

Claims 14 to 23, 26, and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,268,140 (“Rutz et al.”) and U.S. Patent No. 5,047,391 (“Bock et al.”). It is respectfully submitted that the combination of Rutz et al. and Bock et al. does not render unpatentable the present claims for at least the following reasons.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (*See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied*, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)).

The Office Action admits that Rutz et al. do not disclose postforming, and instead refers to Bock et al. as allegedly disclosing this feature. However, Rutz et al. relate to making of a magnetic core component. Bock et al., on the other hand, relate to producing solid bodies made from high-temperature, super-conductive material. These references are therefore within two entirely different fields of endeavor. A person of ordinary skill in the art seeking to modify the magnetic core component of Rutz et al. would not look to the field of producing solid bodies made from high-temperature, super-conductive material. In particular, technical properties important for each are different. For at least this reason, it is submitted that there is no suggestion in the prior art to combine Rutz et al. and Bock et al.

Furthermore, claim 14, as herein amended without prejudice, recites:

A method for manufacturing a magnet core for a common-rail injector from a soft magnetic composite material, the method comprising:

providing a starting mixture including an iron powder and an auxiliary pressing agent;

pressing the starting mixture to form a pressed part;

annealing the pressed part;

after the annealing, postforming the pressed part; and

after the postforming re-annealing the pressed part.

Support for the amendment to claim 14 may be found in the Specification, e.g., at page 1, lines 2 to 4, page 2, line 31 to page 3, line 6, and page 3, lines 25 to 32.

Neither Rutz et al. nor Bock et al. relate to manufacturing of a magnet core for a common-rail injector. The combination of Rutz et al. and Bock et al., therefore, does not disclose or suggest a method of manufacturing a magnet core for a common-rail injector. A rejection based on the combination of Rutz et al. and Bock et al. further modified to provide the method of claim 14 for manufacturing a magnet core for a common-rail injector would be based on improper hindsight, for example, in view of the Specification at page 3, lines 25 to 32, which cannot support an obviousness rejection.

It is therefore respectfully submitted that the combination of Rutz et al. and Bock et al. does not disclose or suggest all of the features recited in claim 14.

In view of all of the foregoing, it is respectfully submitted that the combination of Rutz et al. and Bock et al. does not render unpatentable claim 14.

Claims 15 to 23, 26, and 27 ultimately depend from claim 14 and therefore include all of the features recited in claim 14. Accordingly, without passing judgment on the merits of the Final Office Action's assertions regarding the limitations of claims 15 to 23, 26, and 27, it is respectfully submitted that the combination of Rutz et al. and Bock et al. does not render unpatentable claims 15 to 23, 26, and 27, by virtue of these claims' dependence on claim 14. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

Withdrawal of this rejection is therefore respectfully requested.

IV. Rejection of Claim 25 Under 35 U.S.C. § 103(a)

Claim 25 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Rutz et al., Bock et al., and U.S. Patent No. 6,383,281 ("Bayer"). It is respectfully submitted that the combination of Rutz et al., Bock et al., and Bayer does not render unpatentable claim 25 for the following reasons.

Claim 25 depends from claim 14 and therefore includes all of the features of claim 14. Bayer does not correct the deficiencies noted above with respect to the

combination of Rutz et al. and Bock et al. Accordingly, without passing judgment on the merits of the Final Office Action's assertions regarding the features of claim 25, it is respectfully submitted that the combination of Rutz et al., Bock et al., and Bayer does not render unpatentable claim 25, by virtue of this claim's dependence on claim 14. *Id.*

Withdrawal of this rejection is therefore respectfully requested.

V. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: 3/29/06

By: 
KENYON & KENYON LLP
Gerard A. Messina
Reg. No. 35,952

KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO 2664